

Appl. No. 09/718,604
Amdt. Dated 12/6/2005
Response to Office action dated 07/12/2005

REMARKS

Claims 12-19 have been amended per the Examiner's suggestions. Claims 1-37 are pending.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 12-19 have been amended notwithstanding the belief that these claims were allowable. Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Interview Summary

The Practitioner thanks the Examiner for discussing claims 12-19 on December 6, 2005. The Examiner recommended that the preamble be modified to include "medium" not "software program product." The Practitioner agreed.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-37 under 35 USC § 103 as obvious from Nishio et al. (USP 6,381,651) in view of Schmid et al. (USP 6,438,578). This rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*.

Claims 1, 12, 20 and 28:

Claims 1, 12, 20 and 28 are independent. Claim 1 recites, in the body, "the client monitoring browsing activity of an unregistered user who has not entered a profile of any kind."

Appl. No. 09/718,604
Amdt. Dated 12/6/2005
Response to Office action dated 07/12/2005

The Examiner asserted that:

Schmid specifically teaches 'to cause the network client to request supplemental information', col. 6 lines 42-43, but never registration information and the user who did not enter profile information such as past requests, col. 8, lines 52-44.

On page 6, numbered paragraph 3, of the Office Action mailed 07/12/2005, the Examiner asserted that elements in the preamble, not positively recited in the body of the claim, do not provide patentable weight.

As amended, the "unregistered user who has not entered a profile of any kind" is positively claimed in the body. Schmid, at 6:42-43 and 7:14-16, does not address, teach or suggest the feature "but never registration information" or "but the user did not register." The Examiner's assertion is not supported by the cited art. Therefore, the rejection is improper and should be withdrawn.

Claim 1 recites, among other features, "wherein the first recommendation is based on the first one of the plural categories of human interest and not on a user profile of any kind, any particular information about the unregistered user, or any past browsing activity of the unregistered user."

The Examiner asserted that:

Schmid suggests identifying 'the supplemental information to the network client as having originated with the requested information source', col. 7, lines 14-16 which will result from initial request, however, the initial request may have been technically 'registered', but the user did not register.

On page 7, numbered paragraph 7, of the Office Action mailed 07/12/2005, the Examiner asserted that the initial request may have been technically registered and that the user's history file is arguably a profile.

Schmid, like Nishio, requires a user profile, whether entered by the user or created based on the user's history file, in order to provide a recommendation (see Schmid 7:27-54 and 8:40-63). The Specification, at paragraph 0038, discloses that the method may be practiced without any particular

Appl. No. 09/718,604

Amdt. Dated 12/6/2005

Response to Office action dated 07/12/2005

information about the user, such as a user profile. As claimed, the unregistered user does not enter a profile of any kind. Moreover, the first recommendation is not based on any past browsing activity. Since the cited art does not teach or suggest the claimed feature, the rejection is improper and should be withdrawn.

To the extent that claims 12, 20 and 28 have features similar to claim 1, the arguments set forth for claim 1 are applicable to claims 12, 20, and 28. Therefore, claims 1, 12, 20, and 28 are in form for allowance. It is respectfully requested that the rejection be withdrawn.

Claims 2-11, 13-19, 21-27 and 29-37:

By virtue of their respective dependence from claims 1, 12, 20 and 28, claims 2-11, 13-19, 21-27 and 29-37 are patentable over Nishio in view of Schmid. It is respectfully requested that the rejection be withdrawn.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.


In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Appl. No. 09/718,604
Amdt. Dated 12/6/2005
Response to Office action dated 07/12/2005

Respectfully submitted,

Date: December 6, 2005



Joel G. Landau, Reg. No. 54,732

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com